

## REMARKS

In the Office Action, claims 1-20 were rejected. By the present Response, Applicant has amended claim 16 and added new claims 21-23. Thus, claims 1-23 are currently pending and presented for examination in the present patent application. Reconsideration of the application in view of the following comments is respectfully requested.

### Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 16-18 under 35 U.S.C. § 102(b) as being anticipated by Chaban (U.S. Patent No. 5,738,475). Specifically, the Examiner stated:

a. Claim 16. Chaban discloses a body 120; a head 128 disposed at one end of the body 120; a deformable retention member 132 disposed at a generally opposite end of the body 120 from the head 128; and a stop 124 positioned at a predetermined distance from the head 128 to permit control of the deformation of the deformable retention member 132. (See generally 6 and 7; column 7 lines 21-65).

b. Claim 17. Chaban further shows that the deformable retention member 132 comprises a generally circular lip (figure 7).

c. Claim 18. Chaban also shows that the stop 124 is disposed within the generally circular lip 132 (figure 7).

Applicant respectfully traverses these rejections. A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). If even a single limitation is missing, then the rejection cannot stand.

Independent claim 16 is currently amended to provide that the head is adapted to be secured to the first member. Conversely, in the Chaban reference, the head 128 is not secured to the pivoting portion 88 – for if it was, the pivoting portion 88 could not pivot. Col. 7, lines

22-65; Figs. 6 and 7. Instead, the hollow (deformable) portion 120 of Chaban expands to fill the aperture 118 in the fixed portion 82, thus allowing the portion 88 to pivot. *Id.* Therefore, claim 16 is patentable over the Chaban reference. Claims 17 and 18 are dependent upon independent claim 16 and, thus, are patentable for at least the same reason.

In view of the remarks set forth above, Applicant respectfully submits that the subject matter of claims 16-18 distinguishes over the Chaban reference. Accordingly, Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of claims 16-18.

#### **Rejections under 35 U.S.C. §103**

The Examiner rejected claims 1-15, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over Chaban (U.S. Pat. No. 5,738,475) in view of Whiteside et al (U.S. Pat. No. 3,551,015). The Examiner's comments are lengthy, so they have not been reproduced herein.

Applicant respectfully traverses this rejection and asserts that the claims are not rendered obvious by the cited references. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex*

*parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Furthermore, if the proposed modification would render the modified device unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); M.P.E.P. § 2143.01.

In this case, there is no suggestion or motivation to combine the Chaban and Whiteside references, because the proposed modification would render the Chaban device unsatisfactory for its intended purpose. The Chaban reference discloses an adjustable expansion rivet 92 for connecting a pivotal portion 88 to a fixed portion 82. In the Chaban reference, the pivotal portion 88 is next to the head 128 of the rivet 92 and the fixed portion 82 is at the opposing end of the rivet 92. Col. 7, lines 22-65; Figs. 6 and 7. The Whiteside reference discloses a rivet 10 and collar 20 and the joint formed thereby. In the Whiteside reference, there is no movement between the two panels 40 and 42 joined by the rivets 10. The head 12 of the rivet 10 is embedded into the first panel 40 and the collar 20 is embedded into the second panel 42, thus preventing any movement between the two panels. Figs. 4a-4d.

The Examiner has relied on the teaching of the Whiteside reference to cure a deficiency of the Chaban reference. Specifically, the Examiner relied on the teaching of the first panel 40 having a plastically deformed region receiving the head 12 to form a substantially flat surface with the first panel 40 to secure the rivet 10 to the first panel 40. However, it is clear that the

embedding of the head 128 of the rivet 92 of the Chaban reference, in view of the teachings disclosed in the Whiteside reference, would prevent any movement between the portions 82 and 88. In other words, embedding the head 128 into the portion 88 would prevent the portion 88 from pivoting with respect to the fixed portion 82, thus rendering the Chaban device inoperable. Consequently, the Chaban reference considered in combination with the Whiteside reference does not render unpatentable any of the rejected claims.

In view of the remarks set forth above, Applicant respectfully submits that the subject matter of claims 1-15, 19 and 20, as well as new claims 21 and 22, distinguishes over the cited combination. Accordingly, Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of claims 1-15, and 19-22.

#### **New Claim 23**

Applicant has also added new claim 23, which is directed to a device to pivotally secure a first member to a second member. The device includes a stop positioned approximately flush with an outer edge of the second member to prevent the deformable retention member from becoming fixedly secured to the second member. Because the recitations of claim 23 are not disclosed by the prior art of record, Applicant respectfully requests allowance of claim 23.

**Conclusion**

In view of the above remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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